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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,260	08/18/2003	Kazuyuki Okamura	030829	1526
23850	7590	09/20/2005	EXAMINER	
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP 1725 K STREET, NW SUITE 1000 WASHINGTON, DC 20006			ROBINSON, MARK A	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

A-12

<b>Office Action Summary</b>	<b>Application No.</b> 10/642,260	<b>Applicant(s)</b> OKAMURA ET AL.	
	<b>Examiner</b> Mark A. Robinson	<b>Art Unit</b> 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5, 6 and 8-13 is/are allowed.
- 6) ☒ Claim(s) 14 and 15 is/are rejected.
- 7) ☒ Claim(s) 4 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 4 and 7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitations of claim 4 are present in both claim 1 and claim 2 (via dependence on claim 1). Claim 7 inherits this deficiency from claim 4.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koetke (US 5760952).

Koetke shows an operation microscope including an observation system with objective lens(3), an illumination system(7), and a deflection means, wherein the deflection means includes a pair of deflection members(1,2) guiding light at equal predetermined angles with respect to the optical axis (see fig. 7) and being disposed on opposite sides of the optical axis so as to sandwich the optical axis(5) of the observation system therebetween (shown in fig. 7). Note that one deflection member is between the illumination system and the optical axis and the other is on an opposite side of the optical axis so as to sandwich the optical axis therebetween.

Koetke shows an angle of one of the beams deflected by a deflection member to be within the claimed range (note the angle the light from reflector 2 makes with the axis of lens 3), but does not teach both of the deflection angles to be within this range. However, these angles will depend upon the working distance of the microscope. Larger working distances which result in small deflection angles such as those claimed are well known and desirable for surgical applications. It would have been obvious to the ordinarily skilled artisan at the time of invention to change these deflection angles in Koetke's microscope in order to provide an increased working distance for the microscope.

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4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Koetke (US 5760952) in view of Kaneko (US 5627613).

Koetke shows an operation microscope including an observation system with objective lens(3), an illumination system(7), and a deflection means, wherein the deflection means includes a pair of deflection members(1,2) guiding light at equal predetermined angles with respect to the optical axis (see fig. 7) and being disposed on opposite sides of the optical axis so as to sandwich the optical axis(5) of the observation system therebetween (shown in fig. 7). Note that one deflection member is between the illumination system and the optical axis and the other is on an opposite side of the optical axis so as to sandwich the optical axis therebetween.

Koetke appears to show in fig. 2A a third deflection member(1b) guiding light at a larger angle than the other deflection members (note the portion of light deflected from member 1b and passing member 1a), but it is not clear if this deflected light is actually reaching the eye to be operated on. However, Kaneko shows a third deflection member(9/10) which guides a portion of light at a larger angle than the other deflection members in fig. 4. It would have been obvious to the ordinarily skilled artisan at the time of invention to include a

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third deflection member in Koetke's device in order to provide for more oblique illumination as taught by Kaneko.

***Allowable Subject Matter***

5. Claims 1-3,5,6 and 8-13 are allowed.

6. Claim 1 is a linking claim and is allowable. Accordingly, the restriction requirement as to the encompassed inventions is hereby withdrawn and claims 8-10 are no longer withdrawn from consideration since these claims depend from or otherwise include each of the limitations of an allowable linking claim.

In view of the above noted withdrawal of the restriction requirement as to the linked inventions, applicant(s) are advised that if any claim(s) depending from or including all the limitations of the allowable generic linking claim(s) be presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

7. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach or

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suggest an operation microscope including the disclosed emitting region adjusting means or equivalents thereof as set forth in the claimed combination.

### ***Response to Arguments***

8. Applicant's arguments with respect to new claims 14 and 15 have been fully considered but they are not persuasive.

Regarding claim 14, applicant has argued that the references do not disclose the claimed angular range, and that such would not have been obvious at the time of invention.

However, this limitation was addressed in the previous office action mailed 4/4/05. Applicant has not addressed the examiner's *prima facie* case of obviousness based upon features which were well known at the time of applicant's invention. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the prior art is insufficient to overcome the rejection.

Regarding claim 15, applicant has argued that the manner in which the prior art meets the limitation of "integral" deflection members has not been set forth.

In response, it should be noted that the term "integral" is sufficiently broad to embrace elements which are fastened

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together. *In re Hotte*, 177 USPQ 326,328. Thus, all of the deflection members shown by both Koetke and Kaneko in their respective devices are "integrally formed" since they are fastened together as a part of the microscope.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (571) 272-2319.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MR

9/15/05

  
MARK A. ROBINSON  
PRIMARY EXAMINER